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Filing date: **07/05/2012**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92052150
Party	Plaintiff Wonderbread 5
Correspondence Address	MEAGAN MCKINLEY-BALL PHILLIPS ERLEWINE & GIVEN LLP 50 CALIFORNIA STREET, 35TH FLOOR SAN FRANCISCO, CA 94111 UNITED STATES mmb@phillaw.com, cac@phillaw.com
Submission	Opposition/Response to Motion
Filer's Name	Cari A. Cohorn
Filer's e-mail	cac@phillaw.com
Signature	/Cari A. Cohorn/
Date	07/05/2012
Attachments	Opp to MTC or Cross-Motion for Sanctions.pdf ( 7 pages )(36352 bytes ) CAC dec opp Cross motion.pdf ( 38 pages )(626596 bytes ) CERTIFICATE OF SERVICE.pdf ( 1 page )(7311 bytes )

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE  
TRADEMARK TRIAL AND APPEAL BOARD**

In re Registration No. 3691948 for the Word Mark WONDERBREAD 5  
(Registered on October 6, 2009)

_____	)	
WONDERBREAD 5,	)	
	)	Cancellation No. 92052150
Petitioner,	)	
	)	
v.	)	
	)	
PATRICK GILLES,	)	
	)	
Registrant.	)	
_____	)	

**PETITIONER’S MEMORANDUM IN OPPOSITION TO REGISTRANT’S  
“CROSS-MOTION FOR SANCTIONS AND/OR MOTION TO COMPEL”**

Petitioner Wonderbread 5 (“Petitioner”) opposes Registrant Patrick Gilles’ (“Registrant”) improper and baseless “Cross-Motion for Sanctions and/or Motion to Compel” (the “Motion”). Contrary to Registrant’s contentions, Petitioner has responded appropriately to each of Registrant’s discovery demands, and there is no basis for the imposition of sanctions or for an order compelling further responses. Registrant’s refusal to withdraw his moot and baseless Motion reflects his true motive: a bad faith attempt to coerce Petitioner into withdrawing its pending motion for sanctions against Registrant. For all of these reasons, Registrant’s motion must be denied.

## **I. FACTS AND PROCEDURAL HISTORY**

Registrant served the interrogatories and document requests that are the subject of this Motion on July 12, 2010. (Declaration of Cari A. Cohorn (“Counsel Dec.”), filed herewith, ¶ 2; Motion, Exs. 2, 3.) Shortly thereafter, on July 30, 2010, Petitioner filed a motion for summary judgment, and the Board suspended all proceedings unrelated to the summary judgment motion on August 6, 2010. (Counsel Dec., ¶ 3.) As such, Petitioner did not respond to the discovery demands at that time. (*Id.*) See *Leeds Technologies Ltd. v. Topaz Comm’ns Ltd.*, 65 USPQ2d 1303 (TTAB 2002) (parties have good cause to cease all activities not directly related to a dispositive motion, including responding to discovery, immediately upon the filing of the motion).

In response to Registrant’s Rule 56(d) motion for discovery, on May 20, 2011 the Board ordered Petitioner to respond to a subset of the interrogatories and document requests. (Counsel Dec., ¶ 4.) Petitioner complied with the Board’s order and timely served its responses on June 20, 2011. (*Id.* at ¶ 5; Motion, Exs. 4, 5.)

Following the Board's denial of Petitioner's motion for summary judgment, Registrant's counsel requested responses to the discovery demands that the Board had not ordered provided in connection with the motion for summary judgment. (Motion, Ex. 1.) Immediately after receiving the letter, Petitioner's counsel attempted to contact Registrant's counsel to arrange a time to meet and confer concerning the outstanding discovery demands. (Counsel Dec., ¶ 7.) Specifically, Petitioner sought to avoid future disputes over the discover demands by attempting to reach an agreement to narrow or eliminate requests directed to irrelevant information or which were entirely duplicative of other requests. In addition, Petitioner hoped to clarify several vague or incomprehensible requests. (*Id.* at ¶ 8.)

Registrant's counsel failed to respond to any attempts to reach him for approximately two weeks, at which time, he indicated that he would contact Petitioner's counsel within the "next couple of days" to schedule Registrant's deposition; in the meantime, Petitioner's counsel agreed to prepare to meet and confer concerning Registrant's written discovery requests. (*Id.* at ¶¶ 9, 10, Exs. A, B.) Registrant's counsel did not contact Petitioner's counsel as promised, and the meet and confer did not take place. (*Id.* at ¶ 11.)

At no time did Petitioner state that it would not provide responses to the discovery requests. (*Id.* at ¶ 12.) To the contrary, despite Registrant's failure to engage in meet and confer efforts, Petitioner's counsel informed Registrant's counsel on May 18, 2012 that supplemental discovery responses would be served on or before May 31, 2012. (*Id.* at ¶ 11, Ex. C.) **The supplemental responses were provided, just as promised.** (*Id.* at ¶ 13, Exs. D, E.)

Immediately after reviewing Registrant's Motion, in which Registrant's counsel claimed never to have received the supplemental responses,<sup>1</sup> Petitioner's counsel emailed copies of the responses, the additional document production, and the accompanying proofs of service. (Counsel Dec., ¶ 14, Ex. F.) Since the provision of supplemental responses rendered the Motion moot (or at the very least premature, since – even assuming the supplemental responses were insufficient – Registrant has not attempted to meet and confer concerning any purported inadequacies), Petitioner requested that Registrant withdraw the Motion. (*Id.*) Registrant has not done so and instead sought to persuade Petitioner to withdraw its (unrelated) pending motion for sanctions against Registrant. (*Id.* at ¶ 15, Ex. G.) Furthermore, Registrant has not complied with TBMP section 523.02's requirement that he inform the Board that issues addressed in the Motion have been resolved. (*Id.* at ¶ 16.)

## **II. THERE IS NO BASIS FOR SANCTIONS AGAINST PETITIONER**

The Board may issue sanctions for discovery misconduct under two circumstances: (1) where a party has violated an order of the Board directing the party to provide discovery responses (TMBP § 527.01(a)); and (2) where a party has stated that it will not provide responses to properly served discovery (TMBP § 527.01(b)). Neither circumstance is present here, and the Motion must therefore be denied.

Registrant concedes that Petitioner complied with the *only* order concerning discovery the Board has issued in this action. (Motion at p. 3, ¶ 11.) Thus, no sanctions are available under TMBP § 527.01(a) for failing to comply with an order. *See, e.g., Nobelle.com LLC v.*

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<sup>1</sup> Although Registrant's Motion states that the supplemental responses were not received, Registrant has submitted no evidence to that effect. In particular, Registrant's counsel has not stated in a sworn declaration or affidavit that the responses were not received. By contrast, Petitioner has submitted proofs of service and a sworn declaration stating that the responses were served on May 31, 2012. (Counsel Dec., ¶ 13, Exs. D, E.)

*Qwest Communications International Inc.*, 66 USPQ2d 1300, 1303 (TTAB 2003) (no basis for request for sanctions where no discovery order issued or violated).

Likewise, no sanctions against Petitioner are available under TMBP § 527.01(b), which permits issuance of sanctions against a party who fails to respond to discovery *and* “has informed the party seeking discovery that no response will be made.” See also 37 C.F.R. § 2.120(g)(2). At no time did Petitioner “expressly state” – as required for sanctions under TMBP § 527.01(b) – to Registrant that Petitioner did not intend to respond to the interrogatories and document requests. In fact, Petitioner informed Registrant on May 18, 2012 that responses would be provided, and those responses were served on May 31, 2012. (Counsel Dec., ¶¶ 11, 13, Exs. D, E.) As such, sanctions under § 527.01(b) are clearly unwarranted.

### **III. PETITIONER HAS RESPONDED TO THE DISCOVERY REQUESTS, AND THERE IS NOTHING FOR THE BOARD TO COMPEL**

Petitioner served responses to all outstanding discovery requests before Registrant’s motion was filed. (Counsel Dec., ¶ 13, Exs. D, E.) As such, there is no further action to be compelled.

The Board should reject any attempt Registrant may make through his reply memorandum to justify this Motion by arguing that, in his view, Petitioner’s discovery responses are inadequate. As an initial matter, Petitioner’s responses are fully appropriate. (*See* Counsel Dec., Exs. D, E.) However, even assuming they were not, an attempt to attack them through a reply memorandum, and in absence of any effort to meet and confer (thereby effectively preventing Petitioner from responding to any of the alleged defects in the responses), would be procedurally improper and impermissible. 37 C.F.R. § 2.120(e) (a “motion to compel ... must be supported by a written statement from the moving party that such party or the attorney therefore has made a good faith effort” to resolve the discovery dispute).

**IV. THIS MOTION WAS BROUGHT FOR AN IMPROPER PURPOSE AND SHOULD BE DENIED ON THAT BASIS AS WELL**

Registrant's failure to withdraw this moot and baseless Motion and to notify the Board that the issues raised in the motion have been resolved (as required by TMBP section 523.02) – particularly coupled with his demand that Petitioner withdraw its pending motion for sanctions against Registrant – reflects that the true object of this Motion was to gain leverage and pressure Petitioner to abandon its meritorious motion for sanctions. There is no other reason why Registrant would persist in pressing a Motion based *solely* on the incorrect assertion that Petitioner had failed to serve its supplemental discovery responses.

Even assuming Registrant's counsel did not receive the documents that were served on May 31, 2012 (despite the absence of any evidence to that effect), he cannot dispute that he received them no later than June 25, 2012. (See Counsel Dec., ¶¶ 14, 15, Exs. F, G.) Although it has been undeniably clear since at least June 25, 2012 that the Motion is moot and unfounded, Petitioner has nonetheless been forced to prepare and file an opposition. Registrant's conduct in refusing to withdraw the motion and/or notify the Board that the *only* dispute at issue in the Motion has been resolved is improper, and the Motion must be denied.

**V. CONCLUSION**

For all of the reasons set forth above, Petitioner respectfully requests that the Board deny Registrant's Motion. Petitioner has responded appropriately to the discovery responses at issue in the Motion, and there is no basis for an order compelling further responses or for sanctions.

Respectfully submitted,

WONDERBREAD 5

Dated: July 5, 2012

PHILLIPS, ERLEWINE & GIVEN LLP

By:           /s/ Cari A. Cohorn          

David M. Given  
Cari A. Cohorn  
50 California Street, 35<sup>th</sup> Floor  
San Francisco, CA 94111  
Telephone: (415) 398-0900  
Facsimile: (415) 398-0911  
Email: dm@phillaw.com  
          cac@phillaw.com  
Attorneys for Petitioner

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE  
TRADEMARK TRIAL AND APPEAL BOARD**

In re Registration No. 3691948 for the Word Mark WONDERBREAD 5  
(Registered on October 6, 2009)

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WONDERBREAD 5,	)	
	)	Cancellation No. 92052150
Petitioner,	)	
	)	
v.	)	
	)	
PATRICK GILLES,	)	
	)	
Registrant.	)	
_____	)	

**DECLARATION OF CARI A. COHORN IN OPPOSITION TO REGISTRANT’S  
“CROSS-MOTION FOR SANCTIONS AND/OR MOTION TO COMPEL”**

1. I am an attorney with the law firm Phillips, Erlewine & Given LLP, counsel of record for Wonderbread 5 (“Petitioner”) in this matter. Unless otherwise stated, I have personal knowledge of the facts set forth in this declaration, and, if called to testify as a witness, could and would testify competently thereto.
2. Registrant’s First Set of Interrogatories and Registrant’s First Requests for Production of Documents were served on Petitioner on July 12, 2010. *See*

Exhibits 2 and 3 to Registrant's Opposition to Petitioner's Motion for Sanctions/Cross-Motion for Sanctions and/or Motion to Compel ("Motion").

3. On July 30, 2010, Petitioner filed a motion for summary judgment in this action. As such, Petitioner did not respond to Registrant's written discovery requests at that time.
4. In response to the motion for summary judgment, Registrant filed a Rule 56(d) motion for discovery, which the Board granted in part and denied in part on May 20, 2011. The Board ordered Petitioner to respond to a specific subset of the responses.
5. Petitioner's Responses to Registrant's First Set of Interrogatories and Petitioner's Responses to Registrant's First Requests for Production of Documents were served on June 20, 2011. *See* Motion, Exs. 4 and 5.
6. Following the Board's denial of Petitioner's motion for summary judgment, by letter dated March 29, 2012, Registrant's counsel requested, *inter alia*, responses to the remaining discovery requests. *See* Motion, Ex. 1.
7. Immediately after receiving the letter on April 5, 2012, I called counsel for Registrant to discuss this matter, and specifically to discuss outstanding discovery issues. I did not speak with Registrant's counsel, but I left a voicemail message requesting a return call.
8. I believed that a discussion of the outstanding discovery requests would help avoid future disputes. For instance, I hoped to gain an understanding of which documents Registrant sought through vague and incomprehensible requests (*e.g.*, Document Request No. 8). In addition, I hoped that counsel would agree to

narrow or eliminate requests that sought irrelevant information and/or were entirely duplicative of other requests (*e.g.*, Interrogatory No. 5, 7; *compare* Document Request Nos. 1 and 2 *with* Document Request No. 3).

9. I continued to request an opportunity to discuss the discovery issues with Registrant's counsel. Attached hereto as Exhibit A is a true and correct copy of an email from me to Registrant's counsel, dated April 9, 2012. I did not receive a response to this email.
10. Despite my repeated attempts to reach Registrant's counsel, I did not receive any communication from him until April 19, 2012. At that time, he agreed that "within the next couple of days" he would provide dates on which Registrant would be available for deposition. I agreed that, in the meantime, I would prepare to discuss the outstanding discovery requests. My understanding was that the meet and confer discussion would take place when Registrant contacted me to discuss scheduling Registrant's deposition. A true and correct copy of an email string memorializing my agreement with Registrant's counsel, which Registrant's counsel confirmed in writing, is attached hereto as Exhibit B.
11. Registrant's counsel did not contact me as promised. I eventually concluded that the meet and confer discussion I had requested was not going to take place. As such, on May 18, 2012, I notified Registrant's counsel that Petitioner would provide further discovery responses on or before May 31, 2012. A true and correct copy of an email from me to Registrant's counsel, dated May 18, 2012, is attached hereto as Exhibit C.

12. At no time did I inform Registrant that Petitioner did not intend to provide further discovery responses.
13. Petitioner's further discovery responses were served on May 31, 2012. Attached hereto as Exhibits D and E, respectively, are true and correct copies of Petitioner's Further Responses to Registrant's First Set of Interrogatories and Petitioner's Further Responses to Registrant's First Set of Requests for Production of Documents.
14. I was out of the office the week of June 18, 2012 and did not read Registrant's Motion until I returned on June 25, 2012. Immediately after reviewing the Motion, in which Registrant's counsel claimed not to have received the further responses, I emailed copies of the responses, the additional document production, and the accompanying proofs of service. A true and correct copy of an email from me to Registrant's counsel (with the attachments omitted), dated June 25, 2012, is attached hereto as Exhibit F. In the email, I requested that Registrant withdraw his Motion.
15. In response, Registrant's counsel stated that he would consider withdrawing the motion and asked Petitioner to withdraw its pending Motion for Sanctions against Registrant. A true and correct copy of Registrant's counsel's email to me, dated June 25, 2012, is attached hereto as Exhibit G. I have not received any further communication from Registrant's counsel concerning the withdrawal of Registrant's Motion.

16. I am informed and believe that Registrant's counsel has not complied with TMBP section 523.02's requirement that he inform the Board that issues addressed in the Motion have been resolved.

I declare under penalty of perjury of the laws of the United States of America that the foregoing statements are true and correct.

Dated: July 5, 2012

/s/ Cari A. Cohorn

Cari A. Cohorn

# **EXHIBIT A**

**Subject:** Wonderbread 5 v. Gilles  
**From:** "Cari A. Cohorn" <cac@phillaw.com>  
**Date:** 4/9/2012 2:42 PM  
**To:** mswyers@TheTrademarkCompany.com  
**CC:** "David M. Given" <dmg@phillaw.com>

Matthew,

We are in receipt of your letter concerning this matter. As I said in my voicemail last week, we are available to discuss the case (including the discovery issues raised in your letter) with you. We disagree with your contentions that your client has any right to the trademark and that he has any viable claims against our client. In addition, your letter asserts that the band is using your client's likeness in its advertising. We are unaware of any such use, and, in fact, this issue was resolved as part of the settlement of your client's state court lawsuit against the band. If you have any evidence that your client's likeness is being used, please provide it, and we will look into the issue.

We have noticed your client's deposition for Friday, April 20. However, we just learned that no conference rooms are available at our office on that date, so we may need to change the date or the location. Please advise us of your client's availability on April 20, as well as during the week of April 23.

Thank you,

--

Cari A. Cohorn

Phillips, Erlewine & Given LLP  
50 California Street, 35th Floor  
San Francisco, California 94111  
v. 415.398.0900  
f. 415.398.0911  
[cac@phillaw.com](mailto:cac@phillaw.com)  
[www.phillaw.com](http://www.phillaw.com)

# **EXHIBIT B**

**Subject:** RE: Wonderbread 5 v. Gilles  
**From:** "Matthew H. Swyers" <mswyers@thetrademarkcompany.com>  
**Date:** 4/19/2012 6:03 PM  
**To:** "Cari A. Cohorn" <cac@phillaw.com>

Cari:

Please allow this email to confirm your recitation below. Thank you for your cooperation in this matter and I will be in touch next week to re-schedule the deposition.

Thank you,

Matthew H. Swyers  
The Trademark Company, PLLC  
344 Maple Avenue West, Suite 151  
Vienna, VA 22180 USA  
Phone (800) 906-8626 x100  
Facsimile (270) 477-4574  
[www.TheTrademarkCompany.com](http://www.TheTrademarkCompany.com)

Make sure to follow us for important tips and information relevant to the protection of your trademarks as well as for promotions and contests involving our services.

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-----Original Message-----

From: Cari A. Cohorn [<mailto:cac@phillaw.com>]  
Sent: Thursday, April 19, 2012 3:17 PM  
To: [mswyers@TheTrademarkCompany.com](mailto:mswyers@TheTrademarkCompany.com)  
Cc: David M. Given  
Subject: Re: Wonderbread 5 v. Gilles

Matthew,

I'm glad we were able to connect this morning to discuss the Wonderbread 5 matter. This will confirm our agreement that:

(1) Because you had been unavailable, the deposition of Patrick Gilles (which had been noticed for tomorrow), will be taken off calendar and rescheduled. Within the next couple of days, you will provide dates in early May on which Mr. Gilles is available; as I mentioned, I am unavailable May 8, 10, and 11.

(2) You will follow up with your client concerning his claim that Wonderbread 5 continues to use his likeness in its advertising, as well as

about a possible settlement demand.

(3) I will review your client's discovery demands that remain outstanding and will be prepared to discuss what additional responses may be warranted.

I am aware you will be out of the office on Monday, so please get back to me no later than the close of business on Tuesday, April 24. Thank you very much, Cari

On 4/16/2012 9:51 AM, Cari A. Cohorn wrote:

Matthew,

Would you please let us know as soon as possible whether your client is available for deposition as noticed on Friday, April 20? If he is not available on Friday, please provide alternative dates, preferably during the week of April 23.

Thank you,  
Cari

On 4/9/2012 2:42 PM, Cari A. Cohorn wrote:

Matthew,

We are in receipt of your letter concerning this matter. As I said in my voicemail last week, we are available to discuss the case (including the discovery issues raised in your letter) with you. We disagree with your contentions that your client has any right to the trademark and that he has any viable claims against our client. In addition, your letter asserts that the band is using your client's likeness in its advertising. We are unaware of any such use, and, in fact, this issue was resolved as part of the settlement of your client's state court lawsuit against the band. If you have any evidence that your client's likeness is being used, please provide it, and we will look into the issue.

We have noticed your client's deposition for Friday, April 20. However, we just learned that no conference rooms are available at our office on that date, so we may need to change the date or the location. Please advise us of your client's availability on April 20, as well as during the week of April 23.

Thank you,

--  
Cari A. Cohorn

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[www.phillaw.com](http://www.phillaw.com)

# **EXHIBIT C**

**Subject:** Wonderbread 5 v. Gilles discovery  
**From:** "Cari A. Cohorn" <cac@phillaw.com>  
**Date:** 5/18/2012 4:43 PM  
**To:** "Matthew H. Swyers" <mswyers@thetrademarkcompany.com>  
**CC:** "David M. Given" <dmg@phillaw.com>

Matthew,

We will provide responses to the interrogatories and document requests that we had not previously responded to, and will produce additional documents, on or before May 31.

Yours truly,

--  
Cari A. Cohorn

Phillips, Erlewine & Given LLP  
50 California Street, 35th Floor  
San Francisco, California 94111  
v. 415.398.0900  
f. 415.398.0911  
[cac@phillaw.com](mailto:cac@phillaw.com)  
[www.phillaw.com](http://www.phillaw.com)

# **EXHIBIT D**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE  
TRADEMARK TRIAL AND APPEAL BOARD

In re Registration No. 3691948 for the Word Mark WONDERBREAD 5  
(Registered on October 6, 2009)

WONDERBREAD 5,	)	
	)	
Petitioner,	)	Cancellation No. 92052150
	)	
v.	)	
	)	
PATRICK GILLES,	)	
	)	
Registrant.	)	
	)	

**PETITIONER’S FURTHER RESPONSES TO REGISTRANT’S FIRST SET OF  
INTERROGATORIES**

Petitioner Wonderbread 5 (“Petitioner”) supplements its responses as follows to the First Set of Interrogatories propounded by Registrant Patrick Gilles (“Registrant”):

## **GENERAL RESPONSE AND OBJECTIONS**

Petitioner's responses herein are based on discovery, investigation and information ascertained to date, and on documents which are presently available to and specifically known to Petitioner, and Petitioner reserves the right to amend, delete, modify or expand upon said responses in light of further discovery and investigation.

In responding to these interrogatories, Petitioner is furnishing to Registrant such information as is presently available to Petitioner. Such information may include hearsay and other forms of information which are neither reliable nor admissible in evidence. Petitioner reserves all objections relating to the inadmissibility of evidence, and reserves the right to introduce at trial evidence which is presently unknown to Petitioner and/or is discovered after the date of these responses.

Petitioner objects to each interrogatory to the extent it seeks information which is not relevant to the subject matter of this action nor reasonably calculated to lead to the discovery of admissible evidence. In particular, Petitioner objects to each request to the extent it seeks information concerning the selection and adoption of the Mark. Petitioner objects to each interrogatory to the extent it seeks information which would violate the attorney-client privilege or the work product rule.

Subject to the foregoing general objections, Petitioner responds to the specific requests as follows:

## SPECIFIC RESPONSES AND OBJECTIONS

### Interrogatory No. 1:

State in detail the nature of the business, operations, and activities conducted by Petitioner.

### Response to Interrogatory No. 1:

Petitioner objects to this Interrogatory on the grounds that it is vague, ambiguous, compound, overbroad, unduly burdensome and harassing. Subject to the foregoing and general objections, Petitioner responds: Petitioner's business activities consist primarily of live music performances. At various times, Petitioner has promoted itself by distributing DVDs including video footage of the band, T-shirts, stickers, pins, and temporary tattoos. Petitioner also maintains a website featuring active members of the band; it has done so using the name "Wonderbread 5" and the URL [www.wonderbread5.com](http://www.wonderbread5.com) since approximately June 20, 1999.

### Interrogatory No. 4:

Describes [*sic*] any periods since Petitioner's alleged date of first use, as set forth in the preceding paragraph, during which Petitioner did not make use of Petitioner's Claimed Mark.

### Response to Interrogatory No. 4:

Subject to the foregoing general objections, Petitioner responds as follows: Not applicable. At all times since the formation of the band and its first live performance in November 1996 to the present, Petitioner has used the Mark.

### Interrogatory No. 5:

With respect to each good and/or service identified in your response to Interrogatory No. 3, state the annual sales in units and dollars from the date of first use of each good and/or service.

**Response to Interrogatory No. 5:**

Petitioner objects to this Interrogatory on the grounds that it is overbroad, compound, unduly burdensome and harassing, it seeks irrelevant information, and it seeks to invade the privacy rights of Petitioner and/or its members.

**Interrogatory No. 6:**

With respect to each good and/or service identified in your response to Interrogatory No. 3, describe in detail the manner in which Petitioner's Claimed Mark is promoted in the United States, including but not limited to the media and mode of any marketing efforts as well as the geographic regions in which said promotions are conducted. Further identify who has been responsible for the promotion of Petitioner's Claimed Mark from the alleged date of first use to the present.

**Response to Interrogatory No. 6:**

Petitioner objects to this Interrogatory on the grounds that it is vague and ambiguous (particularly with regard to the terms "media," "mode" and "marketing efforts"), compound, overbroad, unduly burdensome and harassing. Subject to the foregoing and general objections, Petitioner responds as follows: Please see Petitioner's Response to Interrogatory No. 3.

**Interrogatory No. 7:**

For each medium identified in the preceding interrogatory, state the annual expenditure for advertising and promotion since inception.

**Response to Interrogatory No. 7:**

Petitioner objects to this Interrogatory on the grounds that it is vague and ambiguous, and it seeks irrelevant information, and it seeks to invade the privacy rights of Petitioner and/or its members. Subject to the foregoing and general objections, Petitioner responds: Not applicable.

**Interrogatory No. 8:**

Identify the person or persons who, from the date of Petitioner's claimed first use(s) of Petitioner's Claimed Mark to the present, have been responsible for the marketing and/or promotion of Petitioner's goods and services under Petitioner's Claimed Mark indicating the period during which each person was so responsible.

**Response to Interrogatory No. 8:**

Petitioner objects to this Interrogatory on the grounds that it is vague, ambiguous, compound, overbroad, unduly burdensome and harassing. Subject to the foregoing and general objections, Petitioner responds as follows: Please see Petitioner's Response to Interrogatory No. 3.

**Interrogatory No. 9:**

Identify all advertising agencies, public relations agencies or market research agencies that Petitioner has used, participated with or cooperated with in advertising, marketing or promoting the goods/services identified in response to Interrogatory No. 3, and indicate the time period(s) during which such activities were conducted.

**Response to Interrogatory No. 9:**

Petitioner objects to this Interrogatory on the grounds that it is vague, ambiguous, and compound, and it seeks irrelevant information. Subject to the foregoing and general objections, Petitioner responds: Not applicable.

**Interrogatory No. 15:**

Describe in detail the process during which the name of the band “Wonderbread 5” was selected.

**Response to Interrogatory No. 15:**

Petitioner objects to this Interrogatory on the grounds that it is unduly burdensome and harassing in that the information sought is equally available to Registrant, and it seeks irrelevant information. Subject to the foregoing and general objections, Petitioner responds: Please see documents WB5 027-028, served herewith.

**Interrogatory No. 17:**

Describe in detail the civil litigation dispute between Registrant and Petitioner, including the details of any settlement agreement between Registrant and Petitioner.

**Response to Interrogatory No. 17:**

Petitioner objects to this Interrogatory on the grounds that it is unduly burdensome and harassing in that, as the plaintiff in San Francisco Superior Court Case No. CGC-09-489573, Registrant is fully aware of and/or has access to information concerning that dispute, including the claims and defenses asserted in the action and the resolution thereof. Subject to the foregoing and general objections, Petitioner responds: Shortly after being terminated from Petitioner, Registrant filed a complaint in San Francisco Superior Court against Petitioner (as a general partnership), each of its members, and its agent and manager, alleging ten causes of action for, *inter alia*, breach of contract, intentional interference with prospective economic advantage, and violations of the California Corporations Code.

The thrust of Registrant's allegations was that he was wrongfully expelled from the general partnership. The primary remedy Registrant sought was a buyout of his "interest" in Petitioner's assets, including "its service mark name." (*See, e.g.*, document WB5 007.)

Nowhere in his 37-page complaint did Registrant allege that he had ever used the Mark in commerce, apart from his activities with Petitioner. Nor did he claim in the complaint that he owned the Mark.

In the course of discovery in the civil action, Registrant concealed the fact that – after his termination and without Petitioner's knowledge or consent – he registered the Mark "WONDERBREAD 5." Registrant concealed his conduct despite having been questioned under oath at deposition and served with document requests that, had he complied with his discovery obligations, would have revealed the registration.

On September 3, 2009, Petitioner served Registrant with an Offer to Compromise, pursuant to California Code of Civil Procedure section 998. Section 998 is a statute, similar to Federal Rule of Civil Procedure 68, which promotes settlement by allowing a party to make an offer to compromise before trial. Following service of that Offer, counsel for Petitioner informed counsel for Registrant, in writing, that the Offer constituted "the band's offer to pay for your client's 'interest' in the band."

Registrant accepted Petitioner's Offer to Compromise on October 1, 2009. Petitioner remitted payment to Registrant on October 8, 2009, and Registrant dismissed his complaint, with prejudice, on October 22, 2009, thereby releasing all claims in and to Petitioner and its assets.

Only after settlement of the litigation did Petitioner discover that Registrant had registered the domain name [www.thewonderbread5.com](http://www.thewonderbread5.com). It appears that the domain name was registered in April 2009. The website consists of a single page, bearing a photograph of

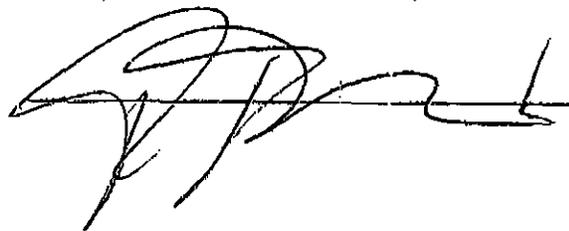


VERIFICATION

Tommy Rickard declares:

I am a member of the Wonderbread 5 general partnership. I am authorized to make this verification on behalf of Wonderbread 5, the Petitioner in this action. I have read **PETITIONER'S FURTHER RESPONSES TO REGISTRANT'S FIRST SET OF INTERROGATORIES** and know the contents thereof. I have personal knowledge that the contents of the responses are true, except as to the matters which are herein stated upon information or belief and as to those matters I believe them to be true.

I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct. Executed the 31 day of May, 2012 at San Francisco, California.



**CERTIFICATE OF SERVICE**

I, Cari A. Cohorn, Esq., certify that on this 31<sup>st</sup> day of May, 2012, a true and correct copy of **PETITIONER'S FURTHER RESPONSES TO REGISTRANT'S FIRST SET OF INTERROGATORIES** was sent by U.S. Mail to:

Matthew H. Swyers, Esq.  
The Trademark Company  
344 Maple Avenue West, Suite 151  
Vienna, VA 22180

Dated: May 31, 2012

PHILLIPS, ERLEWINE & GIVEN LLP

By:       /s/ Cari A. Cohorn      

David M. Given  
Cari A. Cohorn  
50 California Street, 35<sup>th</sup> Floor  
San Francisco, CA 94111  
Telephone: (415) 398-0900  
Facsimile: (415) 398-0911  
Email: [dmg@phillaw.com](mailto:dmg@phillaw.com)  
[cac@phillaw.com](mailto:cac@phillaw.com)  
Attorneys for Petitioner

# **EXHIBIT E**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE  
TRADEMARK TRIAL AND APPEAL BOARD

In re Registration No. 3691948 for the Word Mark WONDERBREAD 5  
(Registered on October 6, 2009)

_____	)	
WONDERBREAD 5,	)	
	)	
Petitioner,	)	Cancellation No. 92052150
	)	
v.	)	
	)	
PATRICK GILLES,	)	
	)	
Registrant.	)	
_____	)	

**PETITIONER’S FURTHER RESPONSES TO REGISTRANT’S FIRST SET OF  
REQUESTS FOR PRODUCTION OF DOCUMENTS**

Petitioner Wonderbread 5 (“Petitioner”) supplements its responses as follows to the First Set of Requests for Production of Documents propounded by Registrant Patrick Gilles (“Registrant”):

## **GENERAL RESPONSE AND OBJECTIONS**

Petitioner's responses herein are based on discovery, investigation and information ascertained to date, and on documents which are presently available to and specifically known to Petitioner, and Petitioner reserves the right to amend, delete, modify or expand upon said responses in light of further discovery and investigation.

In responding to these requests, Petitioner is furnishing to defendant such information as is presently available to Petitioner. Such information may include hearsay and other forms of information which are neither reliable nor admissible in evidence. Petitioner reserves all objections relating to the inadmissibility of evidence, and reserves the right to introduce at trial evidence which is presently unknown to Petitioner and/or is discovered after the date of these responses.

Petitioner objects to each request to the extent it seeks information which is not relevant to the subject matter of this action nor reasonably calculated to lead to the discovery of admissible evidence. In particular, Petitioner objects to each request to the extent it seeks information concerning the selection and adoption of the Mark. Petitioner objects to each request to the extent it seeks information which would violate the attorney-client privilege or the work product rule.

Subject to the foregoing general objections, Petitioner responds to the specific requests as follows:

## **SPECIFIC RESPONSES AND OBJECTIONS**

### **Request No. 1:**

All Documents evidencing, referring, or relating to the selection or adoption by Petitioner of Petitioner's claimed mark.

**Response to Request No. 1:**

Petitioner objects to this Request on the grounds that it is vague, ambiguous, overbroad unduly burdensome and harassing, and it seeks irrelevant information. Subject to the foregoing general objections, Petitioner responds as follows: Petitioner produces herewith all non-privileged documents in its possession, custody or control describing the selection of the band name “Wonderbread 5.”

**Request No. 2:**

Documents sufficient to identify each Person who participated or was involved in the selection of Petitioner’s Claimed Mark, and with respect to each Person so identified, the nature and scope of his or her involvement.

**Response to Request No. 2:**

Petitioner objects to this Request on the grounds that it is vague, ambiguous, overbroad unduly burdensome and harassing, and it seeks irrelevant information. Subject to the foregoing general objections, Petitioner responds as follows: Petitioner produces herewith all non-privileged documents in its possession, custody or control describing the selection of the band name “Wonderbread 5.”

**Request No. 3:**

A copy of San Francisco Superior Court’s stamped and dated “Defendant’s Answer to Complaint for Damages and Equitable Relief: Constructive Fraud, Case No. CGC-09-487573.”

**Response to Request No. 3:**

Petitioner objects to this Request on the grounds that it is vague and ambiguous with respect to the phrases “San Francisco Superior Court’s” and “stamped and dated.” Subject to the foregoing and general objections, and assuming the Request is intended as a request for a filed-

endorsed copy of a document filed with the San Francisco Superior Court, Petitioner responds as follows: No responsive documents exist.

**Request No. 4:**

A copy of San Francisco Superior Court's stamped and dated "Defendant's Offer to Compromise, Case No. CGC-09-487573."

**Response to Request No. 4:**

Petitioner objects to this Request on the grounds that it is vague and ambiguous with respect to the phrases "San Francisco Superior Court's" and "stamped and dated." Subject to the foregoing and general objections, and assuming the Request is intended as a request for a filed-endorsed copy of a document filed with the San Francisco Superior Court, Petitioner responds as follows: No responsive documents exist.

**Request No. 5:**

A copy of San Francisco Superior Court's stamped and dated "Notice of Deposition of Plaintiff Patrick Gilles," Case No. CGC-09-487573."

**Response to Request No. 5:**

Petitioner objects to this Request on the grounds that it is vague and ambiguous with respect to the phrases "San Francisco Superior Court's" and "stamped and dated." Subject to the foregoing and general objections, and assuming the Request is intended as a request for a filed-endorsed copy of a document filed with the San Francisco Superior Court, Petitioner responds as follows: No responsive documents exist.

**Request No. 7:**

A copy of the letter Document from Mr. David M. Given to Douglas B. Wroan dated September 15, 2009 which states in part “as previously discussed, the band has no assets (known), liabilities (and therefore no liquidation value), and no balance sheet or income statement available.”

**Response to Request No. 7:**

Subject to the foregoing general objections, Petitioner produces herewith a copy of the requested letter.

**Request No. 8:**

A copy of San Francisco’s [sic] Superior Court’s stamped and dated copy of the “Offer to Compromise CA CORPORATION CODE 16701 (G) (1) (2) (3) (4).” Case No. CGC-09-487573.

**Response to Request No. 8:**

Petitioner objects to this Request on the grounds that it is unintelligible, vague and ambiguous with respect to the phrases “San Francisco’s Superior Court’s” and “stamped and dated.”

**Request No. 9:**

All Documents pertaining to Wonderbread 5’s advertising and marketing materials posted online or distributed by Petitioner after October 22, 2009, including but not limited to hand bills, flyers, posters, and guitar picks containing Registrant’s photo image, video image, phone number, or address.

**Response to Request No. 9:**

Petitioner objects to this Request on the grounds that it is vague, ambiguous, overbroad, unduly burdensome and harassing, and it seeks irrelevant information. Subject to the foregoing and general objections, and assuming the Request is limited to only materials bearing Registrant's photo image, video image, phone number, or address, Petitioner responds as follows: No responsive documents exist.

**Request No. 10:**

The Document sent electronically by David M. Given to Douglas Wroan on Thursday, October 1, 2009 at 4:46 pm which states in part "I do not want to put the client to the expense of spending the appearance fees. I believe we can transact the remainder of this matter without the formality of filing the 998 with the court."

**Response to Request No. 10:**

Subject to the foregoing general objections, Petitioner produces herewith the requested document.

**Request No. 11:**

Any and all Documents evidencing actual confusion as noted in the Petition to Cancel when Petitioner claims, "the Band received many calls and emails from fans and clients inquiring as to why Registrant appeared to be operating under the Wonderbread 5 name."

**Response to Request No. 11:**

Subject to the foregoing general objections, Petitioner responds as follows: Petitioner produces herewith all responsive documents that it has been able to locate through a reasonable and diligent search. Petitioner will supplement this response if additional responsive documents can be located.

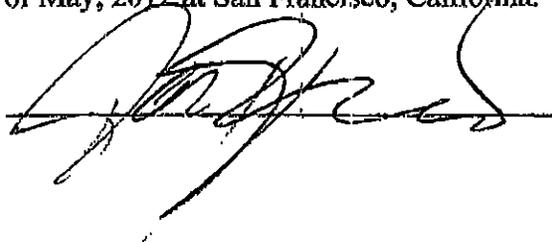


VERIFICATION

Tommy Rickard declares:

I am a member of the Wonderbread 5 general partnership. I am authorized to make this verification on behalf of Wonderbread 5, the Petitioner in this action. I have read **PETITIONER'S FURTHER RESPONSES TO REGISTRANT'S FIRST SET OF REQUESTS FOR PRODUCTION OF DOCUMENTS** and know the contents thereof. I have personal knowledge that the contents of the responses are true, except as to the matters which are herein stated upon information or belief and as to those matters I believe them to be true.

I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct. Executed the 31 day of May, 2012 at San Francisco, California.



**CERTIFICATE OF SERVICE**

I, Cari A. Cohorn, Esq., certify that on this 31<sup>st</sup> day of May, 2012, true and correct copies of **PETITIONER'S FURTHER RESPONSES TO REGISTRANT'S FIRST SET OF REQUESTS FOR PRODUCTION OF DOCUMENTS**, as well as **DOCUMENTS BATES NUMBERED WB5 019-028** were sent by U.S. Mail to:

Matthew H. Swyers, Esq.  
The Trademark Company  
344 Maple Avenue West, Suite 151  
Vienna, VA 22180

Dated: May 31, 2012

PHILLIPS, ERLEWINE & GIVEN LLP

By:           /s/ Cari A. Cohorn          

David M. Given  
Cari A. Cohorn  
50 California Street, 35<sup>th</sup> Floor  
San Francisco, CA 94111  
Telephone: (415) 398-0900  
Facsimile: (415) 398-0911  
Email: [dmg@phillaw.com](mailto:dmg@phillaw.com)  
[cac@phillaw.com](mailto:cac@phillaw.com)  
Attorneys for Petitioner

# **EXHIBIT F**

**Subject:** RE: Wonderbread 5 v. Gilles  
**From:** "Matthew H. Swyers" <mswyers@thetrademarkcompany.com>  
**Date:** 6/25/2012 1:45 PM  
**To:** "Cari A. Cohorn" <cac@phillaw.com>  
**CC:** "David M. Given" <dmg@phillaw.com>

Cari:

I will review the documents and see if we can comply with your requests. Along the same line, and now that you have read our response and are aware that, in our opinion we have never denied you have a right to depose Mr. Gilles and we will produce Mr. Gilles are you willing to withdraw your motion so that we may move forward with the litigation of the case?

Let me know.

Thanks,

Matthew H. Swyers  
The Trademark Company, PLLC  
344 Maple Avenue West, Suite 151  
Vienna, VA 22180 USA  
Phone (800) 906-8626 x100  
Facsimile (270) 477-4574  
[www.TheTrademarkCompany.com](http://www.TheTrademarkCompany.com)

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-----Original Message-----

From: Cari A. Cohorn [<mailto:cac@phillaw.com>]  
Sent: Monday, June 25, 2012 4:39 PM  
To: Matthew H. Swyers  
Cc: David M. Given; Cari A. Cohorn  
Subject: Wonderbread 5 v. Gilles

Matthew,

We are in receipt of your motion to compel discovery responses from Wonderbread 5, and we note that you indicated you had not received the further responses we agreed to provide. The further responses were served by mail as promised on May 31, as documented in the attached proofs of service. In any event, copies of the responses are attached hereto. As responses to all of Registrant's outstanding discovery requests have been provided, we ask that you withdraw the moot motion to compel.

Very truly yours,

--

Cari A. Cohorn

Phillips, Erlewine & Given LLP  
50 California Street, 35th Floor  
San Francisco, California 94111  
v. 415.398.0900  
f. 415.398.0911  
[cac@phillaw.com](mailto:cac@phillaw.com)  
[www.phillaw.com](http://www.phillaw.com)

# **EXHIBIT G**

**Subject:** Wonderbread 5 v. Gilles  
**From:** "Cari A. Cohorn" <cac@phillaw.com>  
**Date:** 6/25/2012 1:38 PM  
**To:** "Matthew H. Swyers" <mswyers@thetrademarkcompany.com>  
**CC:** "David M. Given" <dmg@phillaw.com>, "Cari A. Cohorn" <cac@phillaw.com>

Matthew,

We are in receipt of your motion to compel discovery responses from Wonderbread 5, and we note that you indicated you had not received the further responses we agreed to provide. The further responses were served by mail as promised on May 31, as documented in the attached proofs of service. In any event, copies of the responses are attached hereto. As responses to all of Registrant's outstanding discovery requests have been provided, we ask that you withdraw the moot motion to compel.

Very truly yours,

--  
Cari A. Cohorn

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f. 415.398.0911  
[cac@phillaw.com](mailto:cac@phillaw.com)  
[www.phillaw.com](http://www.phillaw.com)

—Attachments:—

Further Responses To First Set of Rogs (5-31-12).pdf	204 KB
Further Responses To First Set of RFPD (5-31-12).pdf	164 KB
Documents Produced, WB5 019-028 (5-31-12).pdf	571 KB

**CERTIFICATE OF SERVICE**

I, Rosemary A. Comisky Culiver, certify that on July 5, 2012, a true and correct copy of the following:

**REPLY MEMORANDUM IN SUPPORT OF PETITIONER'S MOTION FOR SANCTIONS**

**PETITIONER'S MEMORANDUM IN OPPOSITION TO REGISTRANT'S "CROSS-MOTION FOR SANCTIONS AND/OR MOTION TO COMPEL"**

**DECLARATION OF CARI A. COHORN IN OPPOSITION TO REGISTRANT'S "CROSS-MOTION FOR SANCTIONS AND/OR MOTION TO COMPEL"**

was sent by U.S. Mail to:

Matthew H. Swyers, Esq.  
The Trademark Company  
344 Maple Avenue West, Suite 151  
Vienna, VA 22180

Dated: July 5, 2012

PHILLIPS, ERLEWINE & GIVEN LLP

By: /s/ Rosemary A. Comisky Culiver

David M. Given  
Cari A. Cohorn  
50 California Street, 35<sup>th</sup> Floor  
San Francisco, CA 94111  
Telephone: (415) 398-0900  
Facsimile: (415) 398-0911  
Email: [dmg@phillaw.com](mailto:dmg@phillaw.com)  
[cac@phillaw.com](mailto:cac@phillaw.com)  
Attorneys for Petitioner